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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Dale W. Malik

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AT&T Legal Department - TKHR

Attn: Patent Docketing

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EXAMINER

CHANG, JUNGWON

ART UNIT

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/685,970	Applicant(s) MALIK, DALE W.	
	Examiner JUNGWON CHANG	Art Unit 2454	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 April 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>4/21/09</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is in response to RCE filed on 3/30/09. New Claim 17 is added.

Claims 1-17 are presented for examination.

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 3/30/09 has been entered.

3. The Information disclosure statement filed on 4/21/09 has been considered.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claim 1 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claim 1 recites “means for receiving, means for prompting, means for conveying and means for indicating”, are non-statutory, as the various recited means are software per se. The specification on page 46, lines 7-23 states in part:

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The message-handling IM client 115a... 115c, the IM receive logic 305,307, the display logic 310, 312, the timing logic 315, the prompting logic 320, the presence logic 325, the convey logic 330, the message-reply logic 340, the message-transfer logic 345, the message-forward logic 350, the IM address append logic 355, the indicator messages 360, the IM addresses 335, session-tracker logic 317, sender-query logic 322, recipient-query logic 332, merge-determination logic 327, IM chat-session-merge logic 337, chat-room logic 342, and other logic components for carrying out the recited functions in the present invention can be **implemented in hardware, software, firmware, or a combination thereof.**

Based on the specification above, the recited means appear to be nothing more than a collection of software means, per se. Please see MPEP § 2106.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dickerman et al, (US 2003/0177184), hereinafter Dickerman, in view of Appelman et al, (US 7,181,497), hereinafter Appelman.

8. As to claims 1 and 4, Dickerman discloses the invention as claimed, including a communication device (fig. 1) comprising:

means for receiving, at a first instant messaging (IM) client (118, fig. 1) from a sender directed to a first IM address (page 7, 0038; 0040, "inviter and invitee device 106 network addresses"; page 8, 0051, "inviter initiated the session with the client device via

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application 110”); and

means for prompting, at the first IM client, the sender to convey the IM message to a second IM address on a second IM client (204, 206, fig. 2; page 8, 0044-0045, “a session invite involves at least two devices 106”; 0047, “messenger clients 108-1 and 108-2, which are in communication with one another”);

means for conveying, by the first IM client, the IM message to a second IM address on a second communication device (204, 206, fig. 2; 0047, “messenger clients 108-1 and 108-2, which are in communication with one another”; 0049-0050).

9. Although indicating by the first IM client to the second IM client that the message originated from the sender is obvious to one of ordinary skill in the art and Dickerman discloses the sender is the inviter who originated the IM message, Dickerman does not specifically disclose indicating to the second communication device that the message originated from the sender. Appelman discloses indicating to the second communication device that the message originated from the sender (fig. 12; col. 8, lines 46-59, “the string T> is inserted in the to/from field 622”). It would have been obvious to one of ordinary skill in the art at the time of the invention was made to combine the teachings of Dickerman and Appelman because Appelman’s teaching would allow the recipient to be aware that where the message is coming from, as taught by Appelman (col. 8, lines 46-59).

10. As to claim 2, it is rejected for the same reasons set forth in claim 1 above. In

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addition, Dickerman discloses a first communication device comprising: a memory component configured to store (fig. 1; memory 116 stores applications 118).

11. As to claim 3, Dickerman discloses wherein the convey logic is further configured to automatically convey the IM message to the second communication device (page 7, 0036, "applications 110 to programmatically/automatically...initiate a peer-to-peer session").

12. As to claim 5, Dickerman discloses further comprising the step of: determining presence of the intended recipient at the second communication device prior to conveying the IM message to the second communication device (page 1, 0009, "first application executing at a first device utilizes online presence information"; page 2, 0018, "presence information...a user is available to engaging in a peer-to-peer session with another entity").

13. As to claim 6, it is rejected for the same reasons set forth in claims 1 and 4 above. In addition, Dickerman discloses determining a presence of the recipient at each of the IM addresses (page 1, 0009, "first application executing at a first device utilizes online presence information"; page 2, 0018, "presence information...a user is available to engaging in a peer-to-peer session with another entity").

14. As to claim 7, it is rejected for the same reasons set forth in claims 1 and 4

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above. However, Dickerman does not specifically disclose determining a last active time for each of the IM addresses. Appelman discloses determining a last active time for each of the IM addresses (500, fig. 9, "time stamp"; col. 6, lines 14-64, "the most recent time in its time stamp field 508"). It would have been obvious to one of ordinary skill in the art at the time of the invention was made to combine the teachings of Dickerman and Appelman because Appelman's teaching would allow the system to detect the IM address of the last instant message sent by the user as taught by Appelman (col. 6, lines 14-35).

15. As to claims 8-10, they are rejected for the same reasons set forth in claim 7 above. In addition, Dickerman discloses determining presence of the intended recipient at the second communication device prior to conveying the IM message to the second communication device (page 1, 0009, "first application executing at a first device utilizes online presence information"; page 2, 0018, "presence information...a user is available to engaging in a peer-to-peer session with another entity").

16. As to claim 11, it is rejected for the same reasons set forth in claim 1 above. In addition, Dickerman discloses a computer-readable storage medium comprising: computer-readable code adapted to instruct a programmable device (fig. 1; memory 116 stores applications 118).

17. As to claim 12, it is rejected for the same reasons set forth in claim 5 above.

18. As to claim 13, it is rejected for the same reasons set forth in claim 7 above. In addition, Appelman discloses a computer-readable storage medium comprising: computer-readable code adapted to instruct a programmable device (fig. 1; memory 116 stores applications 118).

19. As to claim 14-16, they are rejected for the same reasons set forth in claim 7 above. In addition, Appelman discloses determining presence of the recipient at each of the IM addresses (page 1, 0009, "first application executing at a first device utilizes online presence information"; page 2, 0018, "presence information...a user is available to engaging in a peer-to-peer session with another entity").

20. As to claim 17, Appelman discloses wherein the first IM address is associated with a different user than the second IM address (page 8, 0044-0045, "a session invite involves at least two devices 106").

21. Applicant's arguments with respect to claims 1-17 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

22. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

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Shah, US 2005/0080848, Lo et al, US 2005/0060377, Daniell et al, US 2004/0158611, Davis et al, US 2004/0158610, Beyda, US 7,461,378, Fernandez et al, US 2004/0249953, Swearingen et al, US 2004/0196315 disclose method and system for presence state detection in an instant messaging system.

23. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jungwon Chang whose telephone number is 571-272-3960. The examiner can normally be reached on 6:30-2:00 (Monday-Friday).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nathan J. Flynn can be reached on 571-272-1915. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/JUNGWON CHANG/
Primary Examiner, Art Unit 2454
June 7, 2009